

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed April 14, 2004 ("*Office Action*"). Claims 1-43 were pending in the Application. The Examiner rejects Claims 1-6, 8-26, 28-31, 34-38, and 40-43 and objects to Claims 7, 27, 32, 33, and 39. Applicant amends Claims 8, 18, and 28. Applicant respectfully requests reconsideration and favorable action in this case.

Allowable Subject Matter

The Examiner objects to Claims 7, 27, 32-33, and 39 as being dependent upon a rejected base claim, but indicates that each of these claims would be allowable if rewritten in independent form to include all the limitations of the respective base claim and any intervening claims. Applicant thanks the Examiner for the timely and favorable consideration of these claims. However, Applicant elects not to rewrite these claims in independent form at this time.

Claim Rejections - 35 U.S.C. §112

The Examiner rejects Claims 8 and 9 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant respectfully submits that this rejection is obviated due to Applicant's amendment of Claim 8. Applicant therefore respectfully requests the Examiner to reconsider and withdraw the §112, second paragraph rejection of Claims 8 and 9.

"Operable to" Claim Language

The Examiner indicates that the "operable to" claim language found in Claims 1, 11, 17, 21, 31, 34-35, 38, 41, and 43 may not have been considered. The Examiner states:

Claims 1, 11, 17, 21, 31, 34-35, 38, 41, [and] 43 specify "operable to" [which] is like saying adapted to and it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138 [(CCPA 1946)].

Office Action, pages 3-4. In response, Applicant respectfully points out that using functional language in claims is proper:

There is nothing inherently wrong with defining some part of an invention in function terms. Functional language does not, in and of itself, render a claim improper. . . . A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used.

M.P.E.P. §2173.05(g). Furthermore, although the Examiner does not reject these claims, the Board of Patent Appeals and Interferences has reversed Examiners in similar circumstances where Examiners have relied upon *In re Hutchison* to reject claims under 35 U.S.C. §112, second paragraph. See, e.g., *Ex parte Brick*, 2001 WL 1738852 (Bd. Pat. App. & Int. 2001).

For at least these reasons, Applicant requests the Examiner to consider the “operable to” claim language found in Claims 1, 11, 17, 21, 31, 34-35, 38, 41, and 43.

Claim Rejections - 35 U.S.C. §103

The Examiner rejects Claims 1-6, 8-26, 28-31, 34-38, and 40-43 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,643,259, which issued to Borella et al. (“*Borella*”), in view of U.S. Patent No. 6,647,424, which issued to Pearson et al. (“*Pearson*”). To establish obviousness of a claimed invention under §103, all claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03.

Applicant’s independent Claim 1 recites:

A method for managing data streams, comprising:
receiving a plurality of packets, each packet associated with a data connection, at least some of the packets being part of a data stream;
performing congestion control by discarding at least some of the packets; and
setting an indicator in at least some of the subsequent packets in the data stream if packets have been discarded from the data stream, the indicator operable to indicate that packets in the data stream have been discarded.

Applicant respectfully submits that *Borella* and *Pearson*, whether taken alone or in combination, fail to teach or suggest every element of this Claim.

Before addressing specific elements of Claim 1 not shown by the *Borella-Pearson* combination, Applicant first addresses the following statement made by the Examiner:

Claims 1, 11, 21, 31, 36, [and] 38 do not specify how the indicator is set when there are no discarded packets. For example, what if the indicator is always set to discard whether or not packets were discarded. That reads on setting an indicator in subsequent packets if (and if not) packets have been discarded (even if all packets are set to be discarded).

Office Action, page 3. Applicant respectfully submits that this statement includes at least two flaws.

First, the Examiner discusses what the claims “do not specify.” Applicant respectfully submits that the question of patentability requires the Examiner to examine the claim limitations, not what the claims “do not specify.” For example, the Examiner must determine whether all claim limitations are taught or suggested by the prior art. M.P.E.P. §2143.03. What the claims do not specify is irrelevant for purposes of patentability.

Second, the Examiner states a hypothetical scenario, and then uses that hypothetical scenario to reject the claims. Applicant respectfully submits that this method of rejecting the claims is improper. Citing a hypothetical scenario rather than a reference fails to show that the prior teaches or suggests any claim element. Furthermore, to the extent that the Examiner maintains these rejections based on “Official Notice,” “well known prior art,” “common knowledge,” or other information within the Examiner’s personal knowledge, Applicant respectfully requests the Examiner to cite a reference or references in support of these positions or provide an affidavit in accordance with M.P.E.P. §2144.03 and 37 C.F.R. §1.104(d)(2). Applicant notes that while in limited circumstances an examiner may take official notice of facts not in the record or rely on “common knowledge” in making a rejection, “such rejections should be judiciously applied.” M.P.E.P. §2144.03. Also, it is not appropriate for an examiner to take official notice of facts without citing a prior art reference “where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.” *Id.* (citing *In re Ahlert*, 165 U.S.P.Q. 418, 420-21 (C.C.P.A. 1970)).

Now addressing specific elements of Claim 1, the *Borella-Pearson* combination fails to teach or suggest “setting an indicator in at least some of the subsequent packets in the data stream if packets have been discarded from the data stream.” As teaching this element, the

Examiner cites to discussion in *Borella* regarding “DP in TOS.” *Office Action*, page 4. Applicant assumes that the Examiner uses DP to refer to drop priorities, and *Borella* discloses that TOS stands for type-of-service. *Borella*, Col. 5, line 47. *Borella* discusses redefining a TOS field “to indicate a number of relative delay and drop priorities.” *Id.*, Col. 6, lines 46-49. *Borella* also discusses marking the TOS field with bit patterns for each type of traffic contained in a packet so that routers will forward packets with low delay priority instead of those with higher delay priorities and will drop packets with low drop precedence before those with high drop precedence. *Id.*, Col. 6, lines 46-62. However, none of these concepts teaches or suggests “setting an indicator in at least some of the subsequent packets in the data stream *if packets have been discarded from the data stream.*”

To reject this same element, the Examiner also cites to discussion in *Pearson* regarding drop precedence and a DP bit. *Office Action*, page 5. The Examiner first points to language in *Pearson* regarding “generat[ing] a TOS value by masking a header field of the data packet with the TOS mask.” *Pearson*, Fig. 6, step 605. However, masking a header field fails to teach or suggest “setting an indicator.” Furthermore, *Pearson* discloses that this step is used to translate quality of service (QOS) information included in a data packet. *Id.*, Col. 6, lines 56-64. Translating QOS information in a data packet fails to teach or suggest “setting an indicator in at least some of the subsequent packets in the data stream *if packets have been discarded from the data stream.*”

The Examiner also refers to discussion in *Pearson* regarding use of a DP bit “to determine when to drop a packet.” *Id.*, Col. 5, lines 41-65. However, using a DP bit to determine when to drop a packet simply fails to teach or suggest “setting an indicator in at least some of the subsequent packets in the data stream *if packets have been discarded from the data stream.*”

The Examiner refers to a third section of *Pearson* to reject this element of Claim 1. While the Examiner points to lines 1-19, the Examiner fails to identify any particular column of *Pearson*. Nevertheless, Applicant respectfully submits that no section of *Pearson* teaches or suggests “setting an indicator in at least some of the subsequent packets in the data stream *if packets have been discarded from the data stream.*”

The *Borella-Pearson* combination also fails to teach or suggest other elements of Claim 1. For example, consider “the indicator operable to indicate that packets in the data

stream have been discarded.” *Borella* discloses using a drop precedence scheme to determine which packets to drop. *Borella*, Col. 6, lines 46-62. Similarly, *Pearson* discloses using a DP bit in conjunction with a congestion clip table to determine whether to forward or discard a packet. *Pearson*, Col. 5, lines 37-48. However, neither of these concepts teaches or suggests “the indicator operable to indicate that packets in the data stream *have been discarded*.”

For at least these reasons, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of independent Claim 1. For reasons analogous to those discussed above with regard to Claim 1, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of independent Claims 11, 21, 31, 36, and 38. Furthermore, because the remaining claims depend from independent claims shown above to be allowable over *Borella* and *Pearson*, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of dependent Claims 2-6, 8-10, 12-20, 22-26, 28-30, 34, 35, 37, and 40-43.

Furthermore, in response to the Examiner’s statement that “Claim 36 is so broad that it reads on a system where no discards at all have transpired,” Applicant respectfully directs the Examiner’s attention to the language of Claim 36. For example, Claim 36 recites “the header including an indicator *adjusted in the network based on discards of preceding IP packets from the data stream*.” Again, for analogous reasons to those discussed above with regard to Claim 1, Applicant respectfully submits that the *Borella-Pearson* combination fails to teach or suggest this element of Claim 36.

Conclusion

Applicant has made an earnest attempt to place the Application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of the Application in any manner, the undersigned attorney for Applicant stands ready to conduct such a conference at the convenience of the Examiner.

Although no fees are believed to be currently due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

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